

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. GRUDEN and ROBERT B. BROOKS JR.

Appeal No. 97-1147
Application 08/349,087

In contrast with the examiner's position, we find nothing in the Kagiya patent which provides any teaching, suggestion or incentive which would have motivated one of ordinary skill in the art to make the particular selective modifications in

the centrifugal clutch therein as proposed by the examiner. The mere fact that one of ordinary skill in the art, once informed of the desirability of making a magnetic decoupling means of the type defined in appellants' claims on appeal, could achieve this result through the application of routine skill in the art, provides no evidence that such a modification would have been obvious to those of ordinary skill in the art at the time of appellants' invention, absent reliance upon appellants' own disclosure. Moreover, as appellants have pointed out on page 11 of their brief, the examiner's proposed modification of the clutch in Kagiya would appear to be contrary to the express teachings of that patent regarding the desired simplicity of construction, reduced numbers of parts, and inexpensive manufacturing discussed therein (see Col. 1, lines 21-25 of Kagiya).

From our perspective, only hindsight based on appellants' own teachings would have provided any reason for one of ordinary skill in the art to consider a modification in the

centrifugal clutch of Kagiya of the nature urged by the examiner in the rejection before us on appeal so as to arrive at the clutch assembly defined in appellants' independent claims 4 and 7. This

being the case, we will not sustain the examiner's rejection of claims 4 and 7 under 35 U.S.C. § 103 based on the teachings of Kagiya.

The examiner's reliance on and citation of Nerwin v. Erlichman, 168 USPQ 177, 179 (Bd. Pat. Int. 1969), which according to the examiner held that "constructing a formerly integral structure in various elements involves only routine skill in the art," appears to us to be misplaced. We find no such "holding" in Nerwin v. Erlichman. The only statement in that case which we

think may be referred to by the examiner is one which indicates that

"[t]he mere fact that a given structure is integral does not preclude its consisting of various elements."

This statement, in our view, is a construction of the term "integral," and does not appear to stand for the proposition the

examiner now urges.

In light of the foregoing, we must agree with appellants' position that the examiner has failed to make out a prima facie case of obviousness under 35 U.S.C. § 103. A rejection based on §103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty

of supplying the factual basis for the rejection he advances. The examiner may not, because he (or she) doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Since in this case there is an inadequate factual basis to support the examiner's rejection of appellants' claims 4 and 7 under 35 U.S.C. § 103, we are compelled to reverse that rejection.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	